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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KENZO TAKAHASHI, YOSHIKIYO MINAMI, YOUSHIYUKI KANABUCHI, KEIKO TOGAMI, and MORIO MITSUHASHI

Appeal 2016-001600
Application 10/573,373
Technology Center 1700

Before TERRY J. OWENS, RAE LYNN P. GUEST, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 13, 21 and 35–38. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim a method for adding brewing aroma to green coffee beans. Claim 13 is illustrative:

> 13. A method of manufacturing green coffee beans to which brewing aroma is added, comprising:
>
> a fermentation process of bringing green coffee beans, which are unground seeds from coffee berries, a yeast

> suspension containing brewers yeast in an amount of 1.0×10^8 cells/g - 1.0×10^{10} cells/g weight of unground green coffee bean, and a nutritive substance comprising at least one of fruit juice and fruit pulp, the nutritive substance being metabolized by said brewers yeast, into contact with one another to cause alcoholic fermentation under an environment prohibiting infiltration by various bacteria and allowing the temperature and the concentration of carbon dioxide to be controlled for at least 48 hours, to allow the green coffee beans to absorb brewing aroma of at least one of the alcohols and esters produced by the fermentation and enhance the brewing aroma of the green coffee beans; and
>
> a separation process of separating out only said green coffee beans that have passed through the fermentation process.

The References

Robison	US 1,313,209	Aug. 12, 1919
Kirby	US 2,321,148	June 8, 1943
Huige	US 4,970,082	Nov. 13, 1990
Enomoto	US 5,267,507	Dec. 7, 1993
Bradbury	US 6,054,162	Apr. 25, 2000
Zapp	US 6,660,322 A2	Dec. 9, 2003
Pazik	US 2004/0086609 A1	May 6, 2004
Hagiwara	US 2004/0180112 A1	Sep. 16, 2004

The Rejections

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 13 and 38 over Kirby in view of Hagiwara, Huige and Pazik, claims 21 and 37 over Kirby in view of Hagiwara, Huige, Pazik and Zapp, claim 35 over Kirby in view of Hagiwara, Huige, Pazik and Enomoto, claim 36 over Kirby in view of Hagiwara, Huige, Pazik, Enomoto and Bradbury, claims 13, 21, 37 and 38 over Robison in view of Hagiwara, Huige and Pazik, claim 35 over Robison in view of Hagiwara, Huige, Pazik and

Enomoto, and claim 36 over Robison in view of Hagiwara, Huige, Pazik, Enomoto and Bradbury.

OPINION

We reverse the rejections. We need address only independent claim 13, the limitations of which are included in the other independent claims (21, 35 and 36).[1] Claim 13 requires a fermentation process comprising contacting green coffee beans, a yeast suspension and a nutritive substance comprising at least one of fruit juice and fruit pulp for at least 48 hours. To meet that claim requirement the Examiner relies upon Kirby or Robison, each in view of Hagiwara (Ans. 2–3, 16–17).

Kirby ferments green coffee beans at 26.5–36 ºC for 15–30 hours or until their mucilaginous coating can be removed readily by washing with water, thereby improving the coffee beans' appearance and the aroma and flavor of coffee prepared from them (p. 1, rt. col., ll. 9–14; p. 2, rt. col., ll. 24–47).

Robison improves the flavor, aroma and palatability of coffee by inoculating unroasted (green) coffee with a mold culture, allowing the inoculated coffee to rest for days until the coffee shows active mold growth, and then roasting the coffee (p. 1, ll. 8–25, 56–105).

Hagiwara produces an alcoholic drink having a rich aroma of coffee by inoculating an alcoholic liquor-brewing yeast into malt juice, a solution of saccharified cereals, an extract of wheat bran, fruit juice or the like, incubating the inoculated yeast at about 5 to about 30 ºC for about 2 to about

[1] The Examiner does not rely upon Zapp, Enomoto or Bradbury for any disclosure that remedies the deficiency in the references applied to claim 13 (Ans. 7, 10, 14, 24, 28).

10 days to produce a yeast culture, inoculating a roasted coffee bean extraction residue/saccharide culture medium with the inoculated yeast, fermenting the inoculated culture medium at about 2 to about 30 ºC for 5 to 20 days, removing microbial cells and other insoluble materials from the fermented culture medium, and treating the resulting liquid according to a known procedure to obtain an alcoholic drink (¶¶ 5, 10, 11).

The Examiner concludes that "it would have been obvious to ferment [Kirby's green coffee beans or Robison's green coffee] in the presence of fruit pulp as in Hagiwara as in order to provide nutrients for the yeast and to further impart flavor to the green coffee beans during fermentation" (Ans. 5, 18), and "to produce flavor distinct to what was produced upon the fermentation of [Kirby's] brewer's yeast" (Ans. 31) or "to produce desired flavors and aromas" in Robison's coffee (Ans. 34).

Setting forth a prima facie case of obviousness requires establishing that the applied prior art would have provided one of ordinary skill in the art with an apparent reason to modify the prior art to arrive at the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The Examiner does not establish that the relied-upon reason for using Hagiwara's disclosure regarding preparing an alcoholic drink to modify Kirby's or Robison's method for making coffee would have been apparent to one of ordinary skill in the art from the disclosures in those references. The rejections, therefore, appear to be based on impermissible hindsight in view of the Appellants' disclosure. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) ("A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art").

Accordingly, we reverse the rejections.

DECISION/ORDER

The rejections under 35 U.S.C. § 103 of claims 13 and 38 over Kirby in view of Hagiwara, Huige and Pazik, claims 21 and 37 over Kirby in view of Hagiwara, Huige, Pazik and Zapp, claim 35 over Kirby in view of Hagiwara, Huige, Pazik and Enomoto, claim 36 over Kirby in view of Hagiwara, Huige, Pazik, Enomoto and Bradbury, claims 13, 21, 37 and 38 over Robison in view of Hagiwara, Huige and Pazik, claim 35 over Robison in view of Hagiwara, Huige, Pazik and Enomoto, and claim 36 over Robison in view of Hagiwara, Huige, Pazik, Enomoto and Bradbury are reversed.

It is ordered that the Examiner's decision is reversed.

REVERSED